

### **Remarks**

The Advisory Action dated March 18, 2010, clarified that claims 6-7 and 16-17 remain objected to with potential allowability if rewritten in independent form; and that claims 11-12, 14-15 and 19 stand also rejected under 35 U.S.C. 103(a) over MacLellan (U.S. Patent No. 5,940,006) in view of Shigyo (U.S. Patent No. 6,430,209) and further in view of Thierry Roz (WO 99/60510). Thus, the Final Office Action dated October 19, 2009, indicated the following rejections as modified by the Advisory Action: claims 1-2, 4-5, 9-10, 11-12, 14-15 and 19 stand rejected under 35 U.S.C. § 103(a) over MacLellan (U.S. Patent No. 5,940,006) in view of Shigyo (U.S. Patent No. 6,430,209) and further in view of Thierry Roz (WO 99/60510); claims 3, 8, 13 and 18 stand rejected under 35 U.S.C. § 103(a) over the '006, '209 and '510 references in view of the Okumura reference (U.S. Patent No. 2003/0003942); and claims 20-26 stand rejected under 35 U.S.C. § 102(b) over the '510 reference. In the following discussion, Applicant does not acquiesce in any regard to averments in the Advisory Action or the Office Actions of record (unless Applicant expressly indicates otherwise).

Applicant appreciates the clarification regarding claims 6, 7, 16, and 17, as well as the indication the claims include allowable subject matter.

Applicant respectfully traverses the § 102(b) rejection of claims 20-26 over the '510 reference for lack of correspondence to the claimed invention. For example, the '510 reference does not teach the reading device transmitting a repeat command not containing synchronization information in response to the reading device receiving mutually colliding responses from several of the transponders. The Office Action asserts the SHIFT command is transmitted in response to receiving mutually colliding responses. However, the '510 reference states "if a collision has been detected during one of the response windows, in other words, if the collision indicator has been activated at block 511, it will be necessary to undertake a new interrogation cycle. The interrogation cycle is thus repeated until the time when decision block 518 no longer indicates any collision" Page 15 of the '510 reference and figure 5. Further, figure 5 shows that in response to an indication of a collision at 518 an INT signal is sent to the transponders, not a SHIFT signal. As the Examiner acknowledges repeatedly through the Office Action (*see, e.g.*, page 6), the '510 reference teaches that the INT command includes sync information.

Accordingly, the ‘510 reference lacks correspondence to the claimed invention and the §102(b) rejection of claims 20-26 should be withdrawn.

Applicant further traverses the rejection of claim 25 for lack of correspondence. For example, the ‘510 reference does not correspond to a Next-Time slot command as arranged in the claim. According to M.P.E.P. § 2131, “[t]he elements must be arranged as required by the claim.” The Office Action cites to both the SHIFT signal and the INT signal in attempt to show correspondence to the next-time slot command of claim 25. However, this is an improper rejection under M.P.E.P. § 2131 because the device as claimed sends only one command and the Office Action has cited two. Accordingly the rejection of claim 25 over the ‘510 reference is improper and should be withdrawn.

Applicant respectfully traverses the § 103(a) rejections of claims 1-5, 8-15, 18 and 19, because one of skill in the art would not be motivated to modify the ‘006 reference by including the asserted teachings from the ‘209 reference. The Office Action asserts that a skilled artisan would modify the system of the ‘006 reference by adding to it the synchronization feature characterized by steps 12-19 of figure 2 of the ‘209 reference. As explained in connection with figure 2 of the ‘209 reference, this modification would require adding the necessary circuitry, namely control module 6 and the connecting circuits in the despread-sync-acquisition module 12 (figure 1 of the ‘209 reference), for producing the relevant signals described with steps 12-19 of figure 2. In this instance, the Office Action erroneously concludes that the skilled artisan would combine these teachings in order “to reduce power consumption of the RFID device.” Applicant notes however that the Examiner provides no explanation for how this hypothetical combination of teachings might save power, particularly given that the ‘209 reference does not mention power consumption as being reduced and given one’s expectation that adding significant circuit blocks (modules 6 and 12) would inherently result in increased power consumption (assuming *arguendo* that the apparatus would operate). Applicant submits one would not be motivated to combine the wholly unrelated teachings of the ‘006 and ‘209 references (as proposed by the Office Action) based upon unsupported and inherently-contradicted views on how power consumption would be reduced.

Accordingly, the Examiner’s reasoning for combining the two references is not supported by anything in the record except Applicant’s specification. M.P.E.P. § 2142 explains that “impermissible hindsight must be avoided and the legal conclusion must be

reached on the basis of the facts gleaned from the prior art.” The Office Action provides no facts in the prior art to support the conclusion one would be motivated to combine the ‘006 and ‘209 references as asserted. Accordingly, the Office Action has engaged in impermissible hindsight reconstruction, and the § 103(a) rejections should be withdrawn.

The absence of any evidence or logic in support of the Examiner’s rejection is perhaps due to the fact that the prior art teaches away from the Examiner’s asserted combination of teachings, which would result in an inoperable embodiment. Consistent with the recent Supreme Court decision, *M.P.E.P.* § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main (‘006) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (U.S. 2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). The asserted combination of the ‘006 reference with the ‘209 reference and the ‘510 reference renders the device of the ‘006 reference inoperable. The Office Action asserts that either the ‘510 reference’s SHIFT signal or the MUTE signal correspond to a command that does not contain synchronizing information. The ‘510 reference’s SHIFT signal tells the transponders to move to the next time period. Adding the SHIFT signal to the ‘510 reference would affect the Time Slots of the ‘006 reference and render the Code Division Multiple Access (CDMA) protocol inoperable because it would change the relationship between Time Slot length and coding space required for multiple RFID tags to be recognized in a given Time Slot as required by the ‘006 reference. *See* Col 13:46- Col 14:46. Were the MUTE signal to be integrated into the ‘006 device, the resultant system similarly becomes inoperable. The MUTE signal of the ‘510 reference is taught to be used to mute a transponder after it has been identified by the reading device so that it sends no more signals to the reading device. Including the MUTE signal as asserted would prevent the tags of the ‘006 reference from sending the acknowledgment signal required by the ‘006 device, rendering the ‘006 reference inoperable and/or contrary to the intended purpose. Therefore, the § 103 rejections of claims 1-5, 8-15, 18 and 19 are improper under *M.P.E.P.* § 2143.01 and should be withdrawn.

Notwithstanding the above and to facilitate prosecution, Applicant has amended various claims to remove the term “means”. Applicant has also amended claim 1. Support for the amendment to claim 1 can be found, for example, in Figures 10 and 11 and accompanying discussion in the specification.

In view of the above, Applicant believes that each of the rejections is improper and should be withdrawn and that the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the attorney/agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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